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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/357,349	07/14/1999	HUGO ALFONS GEERTS	36813.3	9100
35893	7590	05/17/2004		
GREENBERG TRAUIG, LLP ONE INTERNATIONAL PLACE, 20th FL ATTN: PATENT ADMINISTRATOR BOSTON, MA 02110			EXAMINER TURNER, SHARON L	
			ART UNIT	PAPER NUMBER
			1647	

DATE MAILED: 05/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/357,349

Applicant(s)

GEERTS ET AL

Examiner

Sharon L. Turner

Art Unit

1647

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-9, 17, 18, 24, 41, 44, 58 and 59 is/are pending in the application.
- 4a) Of the above claim(s) 17-18, 24, 41, 44, 58 and 59 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 7-9, 17, 18, 24, 41, 44, 58 and 59 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Continued Prosecution Application

1. The request filed on 9-24-03 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/357,349 is acceptable and a CPA has been established. An action on the CPA follows.
2. Claims 7-9, 17-18, 24, 41, 44 and 58-59 are pending.

Election/Restriction

3. Applicant's election of Group I, claims 7-9 (polypeptide of SEQ ID NO:3) in Paper No. 19 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). As amended the invention is now drawn to SEQ ID NO:4 and is under examination as being suitably related in structure. In particular, SEQ ID NO:3 is a 113 amino acid segment completely shared within SEQ ID NO:4. In particular SEQ ID NO:3 corresponds to residues 27-139 of SEQ ID NO:4. SEQ ID NO:4 is longer and provides the Pro domain of Enovin.
4. Claims 17-18, 24, 41, 44 and 58-59 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made without traverse in Paper No. 19.

Claim Objections

5. Claims 8 is objected to as missing a conjunction between the phrases "encoded by a nucleic acid molecule encoding said growth factor" and :comprising the amino acid sequence from position 27 to 139 of the amino acid sequence illustrated in Figure 1, known as SEQ ID NO:3.

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6. Applicant is advised that should claim 7 be found allowable, claim 8 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). Claims 7-8 both appear to recite a peptide comprising SEQ ID NO:4 and hence are substantially duplicative. Having is open language and is considered the same as comprising. Applicants should strike one of the claims or change the scope for example to consisting of SEQ ID NO:4.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74

(Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 8 recites the broad recitation "comprising the amino acid sequence from position 27 to 139 of the amino acid sequence illustrated in Figure 1", and the claim also recites "having the amino acid sequence known as SEQ ID NO:4", which is the narrower statement of the range/limitation.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 7-9 are rejected under 35 U.S.C. 102(e) as being anticipated by
Johansen et al., US Patent No. 6,593,133, July 15, 2003.

Johansen et al., teach Neublastin neurotrophic factors corresponding with 100 % similarity to instant SEQ ID NO:4, see in particular Johansen et al., SEQ ID NO:10. As noted in Johansen the peptide comprises a Pro domain which is cleaved to the mature form as disclosed in SEQ ID NO:12. Hence, instant SEQ ID NO:3, corresponding to residues 27-139 of SEQ ID NO:4 is anticipated by Johansen SEQ ID NO:12. Thus, the reference teachings anticipate the claimed invention, see in particular sequence listing and columns 5-6.

11. Claims 7-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Milbrandt et al., US Patent No. 6,284,540, September 4, 2001.

Milbrandt et al., teach Artein neurotrophic factors corresponding with 100 % similarity to instant SEQ ID NO:4, see in particular Milbrandt et al., SEQ ID NO:5. As noted in Milbrandt the peptide comprises a Pro domain which is cleaved to the mature form as disclosed in SEQ ID NO:3. Hence, instant SEQ ID NO:3, corresponding to residues 27-139 of SEQ ID NO:4 is anticipated by Johansen SEQ ID NO:3. Thus, the reference teachings anticipate the claimed invention, see in particular sequence listing and columns 4-6.

Status of Claims

12. No claims are allowed.

13. Any inquiry of a general nature or relating to the status of this general application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Papers relating to this application may be submitted to Technology Center 1600, Group 1640 by facsimile transmission. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). Should applicant wish to FAX a response, the current FAX number for Group 1600 is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharon L. Turner, Ph.D. whose telephone number is (571) 272-0894. The examiner can normally be reached on Monday-Friday from 8:00

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AM to 4:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz can be reached at (571) 272-0887.

A handwritten signature in black ink, appearing to read "Sharon L. Turner".

Sharon L. Turner, Ph.D.

May 5, 2004